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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,629	06/19/2000	Connie L. Chapman	FE0040355504	4379

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EXAMINER

BLAIR, DOUGLAS B

ART UNIT	PAPER NUMBER
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2142

MAIL DATE	DELIVERY MODE
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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/596,629	<b>Applicant(s)</b> CHAPMAN ET AL.	
	<b>Examiner</b> Douglas B. Blair	<b>Art Unit</b> 2142	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 11-19, 21-28, 30-39, 41-49, 51-58, 60-68 and 70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-19, 21-28, 30-39, 41-49, 51-58, 60-68 and 70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 1-9, 11-19, 21-28, 30-39, 41-49, 51-58, 60-68, and 70 are currently pending.

### ***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The applicant's specification does not describe what a computer-readable medium comprises as claimed in claims 61-68 and 70.

### ***Response to Arguments***

3. Applicant's arguments filed 12/27/2007 have been fully considered but they are not persuasive. The applicant disagrees that the claimed invention is unpatentable in view of Hager and Kuzma. The applicant argues that Hager does not teach key features of the applicant's claimed invention and that Kuzma does not render these claimed features obvious. The Examiner disagrees with the arguments that Kuzma does not render the claimed invention obvious in combination with Hager.
4. Hager is directed towards a workflow system for processing an invention disclosure and forwarding it to selected individuals for review. It has been acknowledged that Hager does not explicitly teach (a) sending a hyperlink to a document rather than the document itself, (b) creating an attachment to a disclosure separately from the disclosure itself; and (c) sending the attachment without the use of a hyperlink. Kuzma has been relied upon to show that these

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concepts are well known in the context of email systems and thus combinable with a system that uses email such as that taught by Hager.

5. So as to limitation (a), the whole point of the Kuzma invention is to send an email with a hyperlink to information (in Kuzma this information happens to be an attachment) instead of the information itself. The motivation for doing this is to conserve bandwidth (col. 1, lines 44-47). Thus someone implementing the teachings of Hager, which require sending an entire disclosure through email, could alternatively send only a link, such as shown in Kuzma, to conserve bandwidth.

6. As to limitation (b), Kuzma clearly shows the creation of an attachment separate from an email. Any attachment is created separately from the email itself. The motivation for combining an emailed disclosure, such as that taught by Hager, with a separate attachment is that an inventor might want to send detailed information such as graphics and word processing files that are not regularly supported by email clients (See Kuzma, col. 1, lines 24-29).

7. As to limitation (c), Kuzma does teach sending an attachment without a hyperlink. This scenario is explicitly mentioned in the background. Furthermore it is unclear why in claims such as claim 12, the applicant's invention is sending an attachment to some evaluators and only a hyperlink to others.

8. Finally the applicant argues that even if Hager and Kuzma are combined it would not have been obvious to select an option to attach a file as claimed. Hager teaches email. Adding attachments to email via an option is well known and shown by Kuzma (col. 1, lines 21-34). Therefore the concept of providing an option to attach something to an email is well known and thus renders the claim obvious. Notice that pages 14-16 of the applicant's specification disclose

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nothing specific about the applicant's option for providing an attachment. Therefore it is reasonable to interpret the claim broadly. How could an attachment be added without some "option" to attach it?

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-9, 11-19, 21-28, 30-39, 41-49, 51-58, 60-68, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,377,355 to Hager et al. in view of U.S. Patent Number 5,781,901 to Kuzma.

11. Hager teaches the invention substantially as claimed (As in claim 52) including an intranet embodied on a computing device comprising a plurality of software modules for distributing an invention disclosure, the intranet having a plurality of users enrolled therein, each of the plurality of users having associated personnel information stored within the intranet (col. 5, lines 1-15), the intranet comprising: a software module for accessing an invention disclosure template form over the intranet; a software module for accessing an invention disclosure template form, the invention disclosure being created by an inventor and including information about an invention; a software module for selecting an option in the invention disclosure template form to include an attachment with the invention disclosure; a software module for submitting the invention disclosure over the intranet (col. 4, lines 40-61); a software module for

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creating a profile of the invention disclosure based upon a technical area relating to the invention disclosure in response to accessing associated personnel information of the inventor (col. 4, lines 62-67 and col. 5, lines 1-15); a software module for transmitting first notification message via e-mail to a first group of users based upon the created profile, the first group of users being within the plurality of users (col. 4, lines 62-67 and col. 5, lines 1-15); a software module for transmitting a second notification message via e-mail to a second group of users based upon the created profile, the second group of user being within the plurality of users and including a technical review coordinator (col. 6, lines 17-34); a software module for selecting at least one evaluator by the technical review coordinator (col. 9, lines 66-68 and col. 10, lines 1-9); a software module for transmitting a third notification message via e-mail to the at least one evaluator (col. 6, lines 17-34); a software module for submitting evaluation comments by the at least one evaluator (col. 7, lines 5-42); an software module for submitting a recommendation of the invention disclosure by the technical review coordinator based upon the evaluation comments (col. 9, lines 37-57); and a software module for transmitting the recommendation of the invention disclosure via e-mail to the first and second group of users (col. 10, lines 29-58); however Hagar does not teach including an attachment to the invention disclosure created separately from the invention disclosure nor e-mailing a hyperlink to the document.

Official notice is taken that it was well known in the art at the time of the invention to send a hyperlink to a document instead of an entire document. Kuzma illustrates this fact in col. 4, line 65-col. 5, line 24.

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Hager regarding a system for distributing an

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invention disclosure with the idea of sending a hyperlink instead of an entire document because sending only a hyperlink reduces the size of e-mails that would be sent, thus reducing network traffic.

Kuzma teaches a software module comprising instruction for including an attachment to a document the attachment having been created separate from the document (col. 4, line 65-col. 5, line 24). Kuzma further teaches a software module for attaching a file to an email without the use of a hyperlink, the file being created by the inventor separate from the email and including information about the invention that is not included in the email (col. 1, lines 22-30).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Hager regarding a system for distributing an invention disclosure via email with the teachings of Kuzma regarding creating an attachment separately from an email document because creating and sending an attachment separately from a document saves network resources (Kuzma, col. 1, lines 22-50). However the Hager-Kuzma combination does not explicitly teach a software module for attaching a file to the invention disclosure without the use of a hyperlink, the file being created by the inventor separate from the invention disclosure and including information about the invention that is not included in the invention disclosure.

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine teachings of the Hager-Kuzma combination regarding the separate creation of an attachment with the idea that the attachment is not attached with a hyperlink but rather is just attached because it is obvious to omit an element if the element's function is not required (See MPEP section 2144.04). In other words, it would have been

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obvious to just plain attach a Word or Powerpoint document as argued by the applicant rather than attach a hyperlink to such a document (See Kuzma, col. 1, lines 22-34). Either way, the attachment requires some form of link, otherwise one would never know that it is there.

12. As to claims 53, Hager teaches an intranet wherein the software module for transmitting the first notification message is responsive to submission of the invention disclosure (col. 4, lines 62-67 and col. 5, lines 1-15).

13. As to claim 54, Hager teaches an intranet wherein the software module for transmitting the second notification message is responsive to submission of the invention disclosure (col. 6, lines 17-34).

14. As to claim 55, Hager teaches an intranet wherein the profile comprises a functional manager of the inventor, a patent attorney, and technical review person (col. 5, lines 33-41).

15. As to claim 56, Hager teaches a profile comprising information relating to the inventor including the inventor's employee number, department number, building number, phone number and e-mail address (col. 4, lines 62-67 and col. 5, lines 1-15).

16. As to claim 57, Hager teaches an intranet wherein the first group of user comprises a business area manager, a supervisor of the inventor, and the inventor (col. 4, lines 62-67 and col. 5, lines 1-15).

17. As to claim 58, Hager teaches an intranet wherein the second group of users comprises a technical review coordinator, a contract administrator if the invention was developed under government funds, and an intellectual property administrator (col. 7, lines 32-42).

18. As to claim 59, Hager teaches a software module for creating an invention disclosure further comprising instructions for including an attachment (col. 4, lines 40-61).



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19. As to claim 60, Hager teaches a software module for creating an invention disclosure comprising instructions for sending a notification message to a co-inventor (col. 4, lines 40-61).

For reasons discussed above it would have been obvious to include a hyperlink in this message.

20. As to claims 1-11, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

21. As to claims 12-21, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

22. As to claims 22-30, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

23. As to claims 31-41, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

24. As to claims 42-51, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

25. As to claims 61-70, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

### ***Conclusion***

26. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B. Blair whose telephone number is (571) 272-3893. The examiner can normally be reached on 9:00am-5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and (571) 273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Douglas Blair

DBB



ANDREW CALDWELL  
SUPERVISORY PATENT EXAMINER